

**REMARKS**

The Office Action of November 16, 2009 and the references cited therein have been carefully reviewed. Favorable reconsideration and allowance of the claims are requested.

**I. Claim Status and Amendments**

Claims 1-21 presently appear in this application and stand rejected. No claims have been allowed.

By way of the present amendment, independent claims 1, 8, and 15 have been amended to specify that the glycerin fatty acid ester having hydroxyl group is 0.1 to 20 parts by weight based on 1000 parts by weight of the polyol component (B). Support can be found in the disclosure for example, at page 17, lines 1-3 of the original application (i.e., paragraph [0059] of the corresponding published patent application no. 20090318657).

Minor editorial revisions have been made to the claims to better conform to U.S. claim form and practice. Such revisions are non-substantive and not intended to narrow the scope of protection. Such revisions include revising the beginning of the claim to recite "A" or "the" as appropriate to provide appropriate antecedent basis throughout the claims. Support can be found in the claims as follows.

No new matter has been added.

Claims 1-21 remain pending and these claims define patentable subject matter warranting their allowance for the reasons discussed herein.

## **II. Priority Claim**

Applicants note with appreciation the Examiner's acknowledgment of the priority claim and receipt of Applicant's papers filed under §119.

## **III. Obviousness Rejection**

Claims 1-21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Moriga et al. (U.S. Patent Appln. Pub. No. 2002/0104043) in view of (Klosowski et al. (U.S. Patent Appln. Pub. No. 2004/0122145) and Brinkman (U.S. Patent Appln. Pub. No. 2003/0232956) for the reasons set forth on pages 2-4 of the Office Action. This rejection is respectfully traversed.

To clarify the record, Applicants note that the citation of U.S. Patent Appln. Pub. No. 2002/0104043 for Moriga et al. is incorrect. The correct citation is U.S. Patent Appln. Pub. No. 2002/0101043.

The rejection should fall, because the cited prior art references fail to teach, suggest or otherwise make obvious all of the features of amended independent claims 1, 8, and 15, as required to support a *prima facie* case of obviousness. In particular, the cited prior art references of Moriga et al.,

Klosowski et al., and Brinkman do not disclose or suggest the feature of "a glycerin fatty acid ester having hydroxyl group(s), wherein said glycerin fatty acid ester is 0.1 to 20 parts by weight based on 1000 parts by weight of the polyol component (B)" of claims 1, 8, and 15.

As to the primary reference of Moriga et al., the examiner, at the bottom of page 2 of the Office Action, acknowledges that this reference "fails to disclose a glycerin fatty acid ester having hydroxyl groups as another reactant." Instead, the examiner relies on the secondary references of Brinkman and Klosowski et al. for this teaching. However, Applicants respectfully submit that the secondary references, even when combined with Moriga et al., fail to disclose or suggest this feature of the amended claims.

At paragraph [0035], Brinkman discloses:

The amount of fatty polyol suitable for use in certain embodiments of the present invention is 0.5% to 50% by weight, based on the total weight of all polyols in the admixture of components. Preferred is 0.8% to 20%; more preferred is 1 % to 9%; even more preferred is 2% to 8%, and most preferred is 3% to 6%.

However, the invention of amended claims 1, 8, and 15 requires the feature of "(C) a glycerin fatty acid ester having hydroxyl group(s), wherein said glycerin fatty acid ester is 0.1 to 20 parts by weight based on 1000 parts by weight of the polyol

component (B).” In other words, the claims require the glycerin fatty acid ester having hydroxyl group(s) to be present in amount ranging from 0.01% to 2% by weight, based on a polyol component (B). It is believed that this feature is not suggested, nor can it be easily derived from, the disclosure in the secondary references, and in particular, in Brinkman. It should be noted that Klosowski et al. also do not disclose this feature. Further, there is no suggestion in the references, nor was a rationale given in the Office Action, to modify the teachings therein to obtain this amount of this claimed feature and resultant effects achieved by the claimed sealing gasket for closure.

Even assuming that the Office has established a *prima facie* case of obviousness (which it has not) it is well settled that *prima facie* obviousness can be rebutted by the showing of unexpected results. See MPEP, 8<sup>th</sup> edition, revision 7 (July 2008) at §716.02(a) I-IV and §2145.

In the instant case, it is believed that the sealing gasket for closure according to the claims has the unexpected and surprising properties of one or more selected from the group consisting of: (i) low swelling with an alcoholic beverage; (ii) low absorption of the odor of an alcoholic beverage; (iii) toughness; and (iv) no yellowing. These are properties of the sealing gasket for closure of main claims 1, 8, and 15. And,

more particularly, said polyurethane elastomer has the properties of low swelling with an alcoholic beverage and/or low absorption of the odor of an alcoholic beverage.

The cited prior art references do not disclose or suggest these features of the amended and new claims. Brinkman, Moriga et al. and Klosowski et al. do not disclose this benefit. Nor do the references disclose or suggest a compound achieving such properties or how to produce such a compound. Accordingly, it is believed that the sealing gasket for closure of main claims 1, 8, and 15 achieves unexpected and surprising properties that cannot be achieved or predicted by the combined teachings of Brinkman, Moriga et al. and Klosowski et al. It is respectfully submitted such unexpected properties are further evidence of the non-obviousness of the claims.

In view of the above, Applicants respectfully submit that the combined teachings of the cited prior art references fail to disclose or suggest each and every element of the amended main claims 1, 8, and 15; and the claimed invention achieves surprising and unexpected properties over anything that could be expected from the combined teachings of the cited prior art references. For these reasons, main claims 1, 8, and 15 are believed to be novel and unobvious over the combined teachings of Brinkman, Moriga et al. and Klosowski et al. The same arguments are applicable to dependent claims 2-7, 9-14, and 16-21, as these

claims all dependent either directly or indirectly, on independent claims 1, 8, and 15. Thus, the dependent claims are also believed to be novel and patentable over the cited prior art references for the same reasons.

Withdrawal of the rejection is therefore requested.

#### IV. Conclusion


Having addressed all the outstanding issues, this paper is believed to be fully responsive to the Office Action. It is respectfully submitted that the claims are in condition for allowance, and favorable action thereon is requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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